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Serial No. 09/749,709 19412-1773001

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of :
Chengyu Liu et al. :Group Art Unit: 1632
Serial No. 09/749,709 :Examiner: P. Paras
Filed: December 27, 2000 :Response to Paper No. 7
For CONTROLLING OFFSPRING'S SEX RATIO BY TARGETING TRANSGENES ONTO THE SEX CHROMOSOMES

RESPONSE TO RESTRICTION REQUIREMENT UNDER 35 U.S.C. 121

Assistant Commissioner for Patents,
Washington, DC 20231

S I R:

This is in response to the Office Action dated December 13, 2002, which set a three month period for reply. Claims 1-12 remain pending in the present application.

Restriction has been required between (I) claims 1-8 and 12, drawn to a method of producing transgenic mammals, wherein the method comprises pronuclear injection, (II) claims 1, 9 and 11, drawn to a method of producing mammals, wherein the method comprises homologous recombination in ES cells, and (III) claims 1, 10 and 11, drawn to a method of producing transgenic

animals, wherein the method comprises nuclear transfer. This restriction requirement is respectfully traversed.

The Examiner states that inventions I, II and III are distinct from one another, primarily for the reason that they "have different modes of operation."

As an initial point, applicant respectfully disagrees that a separate search is necessarily required for each group. By the Examiner's own statement, Groups I and II are both classifiable in class 800, subclasses 21 and 25. Group III is said to be classifiable in class 800, subclass 24. Thus, there is no indication that a separate search would be required for these Groups.

Additionally, applicant respectfully submits that the Examiner has mischaracterized the Groups. For instance, not all the claims identified in Group I are drawn to a method of producing transgenic mammals including pronuclear injection. Claim 1 recites a method of producing transgenic *animals* and is not necessarily limited to mammals. Only claim 12 deals with pronuclear injection. The other two groups are similarly mischaracterized.

Moreover, applicant disagrees that the Groups identified by the Examiner are distinct inventions. In MPEP § 802.01, the term "distinct" is defined as meaning that two or more subjects as disclosed are related, but are capable of separate manufacture, use or sale as claimed. Here, the allegedly distinct inventions, as claimed, are not capable of separate manufacture, use or sale because they are, in part, defined by the same claims. That is, Groups I, II and III are each said to be defined by claim 1; Groups II and III are both said to be defined by claim 11. Thus, the Groups are not distinct as claimed. As stated in MPEP § 806, restriction is never proper where inventions are related as disclosed but not distinct as claimed.

In addition, MPEP § 803 states that restriction between two or more inventions is proper only if they are able to support separate patents. In

this case, it is respectfully submitted that Groups I, II and III could not support separate patents because they are partly defined by the same claims and 35 U.S.C. 101 precludes more than one patent being issued for the same claims.

For the above reasons, reconsideration and withdrawal of the restriction requirement is respectfully requested.

Applicant provisionally elects Group I, claims 1-8 and 12 for further prosecution.

An action on the merits is awaited.

Respectfully submitted,

3/4/03
Date

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